

REMARKS

FORMAL MATTERS

Claims 1-6, 14, 18, 24 and 29-42 are pending after entry of the amendments above.

Claims 7-13, 15-17, 19-23 and 25-28 are canceled. New claims 29-42 are added. Support for these new claims is found throughout the specification and in the claims as originally filed. For example, new claims 29-36 find support in the specification at page 19, lines 9-13; and new claims 37-42 find support in original claims 2, 4, 6, 14, 18, and 19, respectively

No new matter is added.

RESTRICTION REQUIREMENT:

The Examiner therein required election of one of the following groups of claims:

Group I: Claims 1-5, drawn to a peptide;

If Group I is elected, the Examiner further required election of one of the following fluorophore species:

Texas Red, Rhodamine Red, Oregon Green 514, and Fluorescein

Group II: Claims 6-13, drawn to a complex of a fluorophore with a peptide;

If Group II is elected, the Examiner further required:

-- election of one of SEQ ID NOS:6-11; and

-- election of one of the following fluorophores:

Texas Red, Rhodamine Red, Oregon Green 514, and Fluorescein

Group III: Claims 14-17, drawn to a method of binding a peptide to a fluorophore

Group IV: Claims 18-23, drawn to a method detecting a fluorette; and

Group V: Claims 24-28, drawn to a peptides of defined sequences.

If Group V is elected, the Examiner further required:

-- election of one of the following consensus sequences:

(A) X₁-X₂-X₃-X₄-Y-W-T-X₅-M-F-Y-X₆ (as recited in claim 24)

(B) X₁-P-H-X₂-P-M-Y-W-T-X₃-V-F (as recited in claim 25)

(C) X₁-X₂-W-X₃-Y-X₄-W-D-W-T-X₅-F-W (as recited in claim 26)

(D) Y-X₁-X₂-X₃-X₄-X₅-W-W-X₆-Y-Y-X₇ (as recited in claim 27)

and

-- election of a single species of compound encompassed by the elected consensus sequence.

The Examiner acknowledged that claims 1 and 13 are generic.

The Applicants hereby elect to prosecute the claims of Group V, claims 24-28, with traverse. Applicants further elect formula (A) and the species of SEQ ID NO:15 (KPVQYWTQMFYT), with traverse.

It is applicants' understanding that the election of the peptide of the specific sequence is an election of species. Accordingly, once this species is found patentable, the Examiner is to then consider the patentability of other species within the scope of claim 24. Claim 24 is generic to the elected and non-elected species. New claims 26-36 are directed to other, non-elected species of peptides. Of the claims presently presented and elected, claims 24, 25 and 37-42 read on the elected species.

The grounds for traverse are set out below.

The Restriction Requirement is not consistent with the requirements of MPEP §805.05(c)

According to MPEP §806.05(c),¹ subcombination claims and combination claims may be subjected to restriction only if the combination claims **do not** require the particulars of the subcombination claim for patentability.

The present Restriction Requirement has divided claims directed to peptides (claims 1-5), complexes of peptides and fluorophore dyes (claims 6-13), methods of binding peptides to fluorophore dyes (claims 14-17), and methods of detecting a “fluorette” (which is a fluorophore-binding peptide) by binding with a fluorophore dye (claims 18-23) into separate Groups. Applicants respectfully submit that the subject matter of these claims should be rejoined. Furthermore, applicants respectfully submit that the new claims presented directed to this subject matter and relating to a peptide having the sequence of Formula (A) should be examined together with elected claim 24.

In the nomenclature of MPEP §806.05(c), the peptide of claim 24 is a subcombination. Dependent claims 29-36 are directed to species of peptides that fall within the scope of claim 24, and are also represent a “subcombination”. Claims 39-42, which are directed to combinations of the peptide of claim 24 with a fluorophore dye (e.g., a complex, as claimed in claim 39) and methods of using the peptide of claim 24 in various methods involving its binding to a fluorophore dye. In each of these claims, the patentability of the combination claims can be said to require the particulars of the peptide for patentability. In other words, without the presence of the peptide of claim 24 in claims 39-42, the claims would only recite a fluorophore dye.

Accordingly, withdrawal of the restriction requirement in this regard, and examination of all of claims 24 and 29-42 in a single application is respectfully requested.

¹ MPEP §806.05(c): To support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary.

The inventions are distinct if it can be shown that a combination as claimed:

(A) **does not** require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), **and**

(B) the subcombination can be shown to have utility either by itself or in another materially different combination.

The Applicants expressly reserve the right under 35 USC §121 to file a divisional application directed to the non-elected subject matter or any subject matter disclosed in this application during the pendency of this application.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815, order number STAN-426CON.

Respectfully submitted,
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Date:

Feb 5, 2007

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When these factors cannot be shown, such inventions are not distinct. (emphasis added)